Fazaruddin bin Ibrahim v Parkson Corp Sdn Bhd

HIGH COURT (JOHOR BHARU) — ORIGINATING MOTION NO 25-15-1994
ABDUL MALIK ISHAK J
23 OCTOBER 1996

Trade Marks *— Registered trade mark — Expungement — Application for —Whether applicant was the first user of the trade mark — Whether respondent was an honest concurrent user — Whether registration of similar trade mark by respondent will cause deception and confusion — Whether registration of trade mark by applicant should be expunged — How discretion of court should be exercised*

Words and Phrases *— 'Person aggrieved' — Trade Marks Act 1976 s 45(1)(a)*

The applicant had registered himself as the proprietor of the 'ZIG ZAG' trade mark ('the mark') with the Registrar of Trade Marks on 9 October 1992. On 7 July 1994, he applied for and obtained a trade description order and with that he complained to the Ministry of Trade and Industry which then raided Parkson's ('the respondent') premises and confiscated the infringing goods that bore the mark. The respondent, by way of notice of motion dated 7 November 1994, prayed, inter alia, for an order that the respondent be at liberty (a) to expunge the registration of the mark; and (b) to set aside the trade description order given by the court. The respondent contended that it was also interested in the mark and sought to show that it began using the mark in 1987, although it did not register the mark with the Registrar of Trade Marks. Among the issues for consideration were: (i) the rights of the registered proprietor of the mark; (ii) whether the respondent was a concurrent user of the mark to invoke s 20 of the Trade Marks Act 1976 ('the Act'); (iii) whether the use of the mark was likely to deceive or cause confusion; and (iv) whether the registered proprietor in protecting his proprietorship over the mark had been guilty of a material misrepresentation calculated to mislead the public.

Held, dismissing the respondent's application:

(1) As a registered proprietor, the applicant had the exclusive right to the use of the mark, in relation to those goods, subject to any conditions, amendments, modifications or limitations entered in the register (see p 371E). The applicant therefore had the right to exclude the use of the mark by others. Anyone who used the mark without the applicant's consent would infringe that right and could be sued in court (see p 371F).

(2) To succeed in expunging the registration of the mark in the name of the applicant, the respondent had to show that they were aggrieved by an entry made in the register without sufficient cause or by an entry wrongfully remaining in the register (see p 369B).

(3) The phrase 'person aggrieved' in s 45(1)(a) of the Act should be construed liberally. It included any person whose own application for registration was obstructed by the opposing party in the suit and extended to any person who was alleged to have infringed the registration. It also extended to anyone whose legitimate business might be adversely affected by a wrongful registration (see p 369C); *Powell's Trade Mark* (1894) 11 RPC 4 followed.

(4) The court's powers to order rectification of the register and the expunging of a trade mark under s 45(1)(a) and (b) of the Act respectively were discretionary in nature. Thus the court had a discretion to withhold relief even if a ground for rectification or removal has been made out (see p 370A).

(5) Under common law, the first person who used a trade mark of an appropriate type within a country became the proprietor of the mark. The applicant was the first person to use the mark and he must therefore be the proprietor of that mark. As a common law proprietor, the applicant was not entitled to restrain a later user who was an honest concurrent user of the same trade mark. Based on the facts and circumstances, the respondent was a dishonest concurrent user of the mark and therefore s 20 of the Act, which gave the court a wide discretion to permit the registration of trade marks which were identical subject to such conditions, amendments, modifications or limitations which the court might think fit to impose, could not be invoked (see p 380E–F); *Re Registered Trade Mark 'Yanx', ex p Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199, *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592, *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* (1984) 59 ALJR 77, *Hall v Barrows* (1863) 32 LJ Ch 548 and *GE Trade Mark* [1973] RPC 297 followed.

(6) In deciding whether the registration of a trade mark would be likely to deceive or cause confusion to the public contrary to s 14 of the Act, the court had to be satisfied not merely that there was a possibility of confusion, but it must be satisfied that there was a real tangible danger of confusion if that mark was put on the register. On the facts of the case, confusion would be likely to prevail if the respondent was allowed to register a mark like the mark already registered by the applicant. Therefore the mark as registered by the applicant should not be expunged and the trade description order dated 7 July 1994 should not be set aside (see p 383G).

(7) On the facts of the case, there was no material to show fraud on the applicant's part when he registered the mark. In the absence of fraud, it was not unlawful for the applicant to become the registered proprietor of the mark (see p 385I).

[Bahasa Malaysia summary

Pemohon telah mendaftarkan dirinya sebagai tuan punya cap dagangan 'ZIG ZAG' ('cap tersebut') dengan Pendaftar Cap Dagangan pada 9 Oktober 1992. Pada 7 Julai 1994, dia telah memohon dan telah mendapatkan perintah perihal dagangan dan dengan itu dia telah mengadu kepada Kementerian Perdagangan dan Perindustrian yang telah menyerbu premis Parkson ('penentang') dan telah merampas barangan yang melanggar yang memperlihatkan cap tersebut. Penentang, melalui notis usul bertarikh 7 November 1994, telah memohon, antara lainnya, untuk satu perintah supaya penentang bebas: (a) membatalkan pendaftaran cap tersebut; dan (b) mengetepikan perintah perihal dagangan yang diberikan oleh mahkamah. Penentang menekankan bahawa ia juga mempunyai kepentingan di dalam cap itu dan cuba menuinjukkan bahawa ia telah mula menggunakan cap itu dalam tahun 1987, walaupun ia tidak mendaftarkan cap itu dengan Pendaftar Cap Dagangan. Di antara isu untuk dipertimbangkan adalah: (i) hak tuan punya berdaftar cap tersebut; (ii) sama ada penentang adalah pengguna bersama cap tersebut untuk membawa masuk pemakaian s 20 Akta Cap Dagangan 1976 ('Akta tersebut'); (iii) sama ada penggunaan cap tersebut akan memperdayakan ataupun menimbulkan kekeliruan; dan (iv) sama ada tuan punya berdaftar dalam melindungi kepunyaan cap tersebut adalah bersalah atas salah nyata material yang dijangka akan mengelirukan orang awam.

Diputuskan, menolak permohonan penentang:

(1) Sebagai tuan punya berdaftar, pemohon mempunyai hak eksklusif kepada penggunaan cap tersebut, berkaitan dengan barangan tersebut, tertakluk kepada mana-mana syarat, pindaan, perubahan atau had yang dimasukkan di dalam daftar (lihat ms 371E). Maka pemohon mempunyai hak untuk mengecualikan penggunaan cap tersebut oleh orang lain. Sesiapa yang menggunakan cap tersebut tanpa kebenaran pemohon akan melanggar hak pemohon dan boleh didakwa di mahkamah (lihat ms 371F).

(2) Untuk membatalkan pendaftaran cap tersebut dalam nama pemohon, penentang harus menunjukkan bahawa mereka telah terkilan dengan butir yang dimasukkan dalam daftar tanpa sebab yang munasabah ataupun oleh butir yang tertinggal dalam daftar secara salah (lihat ms 369B).

(3) Ungkapan 'orang yang terkilan' dalam s 45 Akta tersebut hendaklah ditafsirkan secara liberal. Ianya merangkumi sesiapa yang mana permohonannya untuk pendaftaran adalah dihalang oleh pihak bertentangan dalam guaman tersebut dan sesiapa yang dikatakan telah melanggar pendaftaran. Ianya juga

merangkumi sesiapa yang mana perniagaannya yang sah mungkin terjejas oleh pendaftaran yang salah (lihat ms 369C); *Powell's Trade Mark* (1894) 11 RPC 4 diikut.

(4) Kuasa mahkamah untuk memerintahkan pembetulan daftar dan untuk membatalkan sasuatu cap dagangan di bawah s 45(1)(a) dan (b) Akta tersebut adalah bersifat budi bicara. Maka mahkamah mempunyai budi bicara untuk menafikan relief biarpun terdapat dasar untuk membuat pembetulan atau pembatalan (lihat ms 370A).

(5) Di bawah common law, orang yang pertama menggunakan sesuatu cap dagangan yang bersesuaian di dalam sesuatu negara menjadi tuan punya cap itu. Pemohon adalah orang yang pertama menggunakan cap tersebut dan beliau oleh itu mestilah menjadi tuan punya cap tersebut. Sebagai tuan punya di sisi common law, pemohon tidak berhak menyekat seseorang pengguna yang terkemudian yang merupakan seorang pengguna bersama cap itu yang jujur. Berdasarkan fakta dan keadaan kes, penentang merupakan pengguna bersama yang tidak jujur akan cap tersebut dan oleh kerana itu s 20 Akta tersebut, yang memberikan mahkamah budi bicara yang luas untuk membenarkan pendaftaran cap dagangan yang serupa tertakluk kepada mana-mana syarat, pindaan, perubahan ataupun had yang mahkamah fikirkan adalah wajar dikenakan, tidak terpakai (lihat ms 380E–F); *Re Registered Trade Mark 'Yanx', ex p Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199, *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592, *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* (1984) 59 ALJR 77, *Hall v Barrows* (1863) 32 LJ Ch 548 dan *GE Trade Mark* [1973] RPC 297 diikut.

(6) Dalam menentukan sama ada pendaftaran sesuatu cap dagangan mungkin memperdayakan atau mengakibatkan kekeliruan kepada orang awam bertentangan dengan s 14 Akta tersebut, mahkamah mesti berpuas hati bukan sahaja terdapat kemungkinan kekeliruan berlaku, tetapi ianya mesti berpuas hati bahawa terdapat bahaya ketara kekeliruan berlaku jika cap itu dimasukkan ke dalam daftar. Berdasarkan fakta kes, kekeliruan mungkin berlaku jika penentang dibenarkan mendaftarkan satu cap seperti cap yang telah didaftarkan oleh pemohon. Oleh itu cap tersebut seperti yang didaftarkan oleh pemohon tidak patut dibatalkan dan perintah perihal dagangan bertarikh 7 Julai 1994 tidak patut diketepikan (lihat ms 383G).

(7) Berdasarkan fakta kes ini, tidak terdapat sebarang keterangan untuk menunjukkan fraud pada pihak pemohon ketika ia mendafatarkan cap tersebut. Maka, dalam ketiadaan fraud, ianya adalah tidak salah untuk pemohon menjadi tuan punya berdafar cap tersebut (lihat ms 385I).]

Notes

For cases on expungement of trade mark on gounds of confusion and deception, see 12 *Mallal's Digest* (4th Ed, 1996 Reissue) paras 1263–1264 and 1270.

For a case on discretion of the court in expungement of trade mark, see 12 *Mallal's Digest* (4th Ed, 1996 Reissue) para 1271.

Cases referred to

Astronaut Trade Mark [1972] RPC 655 (refd)

AUVI Trademark, Re, Auvi Pte Ltd v Seah Siew Tee & Anor [1992] 1 SLR 639 (refd)

Berlei Hestia Industries Ltd v Bali Co Inc (1968) 118 CLR 128; (1973) 129 CLR 353 (refd)

Berlei (UK) Ltd v Bali Brassiere Co Inc [1969] 2 All ER 812 (refd)

California Fig Syrup Co, Re [1910] 1 Ch 130 (refd)

Carl Zeiss Pty Ltd's Application, Re (1969) 122 CLR 1 (refd)

Dunn's Trade Mark (1890) 7 RPC 311 (refd)

GE Trade Mark [1973] RPC 297 (follld)

General Electric Co v General Electric Co Ltd [1972] 2 All ER 507, [1972] 1 WLR 729 (refd)

George Banham & Co Ltd & Ors v F Reddaway & Co Ltd & Anor [1927] AC 406 (refd)

Hall v Barrows (1863) 32 LJ Ch 548 (follld)

Hannaford & Burton v Polaroid Corp [1976] 2 NZLR 14 (refd)

Imperial Group Ltd v Philip Morris & Co Ltd (1982) 8 FSR 72 (refd)

Jacob v PP [1949] MLJ 70 (refd)

Joseph Crosfield & Sons Ltd, Re [1910] 1 Ch 130 (refd)

Kenrick & Jefferson Ltd's Application, Re (1909) 26 RPC 641 (refd)

Ladd v Marshall [1954] 1 WLR 1489 (refd)

Leather Cloth Co v American Leather Cloth Co (1865) 11 HL Cas 523 (refd)

Lever Bros Port Sunlight v v Sunniwite Products Ltd (1949) 66 RPC 84 (refd)

Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2) (1984) 59 ALJR 77 (follld)

Mrs Pomeroy Ltd v Scale (1906) 24 RPC 177 (refd)

Pang Ah Chee v Chong Kwee Sang [1985] 1 MLJ 153 (refd)

Pembangunan Maha Murni Sdn Bhd v Jururus Ladang Sdn Bhd [1986] 2 MLJ 30 (refd)

Plotzker v Lucas (1907) 24 RPC 551 (refd)

Powell's Trade Mark (1893) 10 RPC 195; (1894) 11 RPC 4 (follld)

Registered Trade Mark 'Yanx', Re, ex p Amalgamated Tobacco Corp Ltd (1951) 82 CLR 199 (follld)

Registrar of Trade Marks v W & G Du Cros Ltd [1913] AC 624 (refd)

Scott v Brown Doering McNab & Co [1891–94] All ER Rep 654 (refd)

Smith Kline & French Laboratories Ltd v Sterling-Winthrop Group Ltd

A [1975] 2 All ER 578 (refd)
Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd (1974) 131 CLR 592 (folld)
Whaley v Carlisle 17 ICLR 792 (refd)
Yah bte Aji v Fatimah bte Hj Mohamed Ariffin & Ors [1969] 2 MLJ 186 (refd)
B *Yong Pak Yong v PP* [1959] MLJ 176 (refd)
Yorkshire Copper Works Ltd v Registrar of Trade Marks [1954] 1 All ER 570 (refd)

Legislation referred to

C Trade Marks Act 1976 ss 3, 14, 20, 30, 35, 36, 45(1)(a), (b), 82

M Nathan (*Brian Komathi* with him) (*Brian Komathi & Partners*) for the applicant.
Tai Foong Lam (*T Siaw* with him) (*Skrine & Co*) for the respondent.

D

Abdul Malik Ishak J: By an ex parte notice of originating motion in encl 4 supported by an affidavit of Fazaruddin bin Ibrahim ('Fazaruddin') that was affirmed on 7 May 1994 (encl 3), Fazaruddin easily obtained a trade description order dated 7 July 1994 (encl 7) before E my immediate predecessor. That trade description order which gave Fazaruddin exclusive use of the 'ZIG ZAG' trade mark was worded in this fashion:

> ADALAH DIPERINTAHKAN bahawa cap dagangan 'ZIG ZAG' *yang dilampirkan bersama ini* atau mana-mana cap dagangan yang serupa dari segi F bunyi amat serupa dengan itu yang dilekatkan, dicapkan, dilabelkan atau yang kelihatan dalam mana-mana bentuk material pada barangan berikut iaitu pakaian, kemeja-kemeja, seluar, jeans, kemeja T, baju wanita atau blaus ('barangan-barangan tersebut') yang tidak dikilangkan, diedarkan, dijual atau diberi kuasa untuk dikendalikan sedemikian oleh pemohon yang dinamakan di atas akan pengilang-pengilang, pengedar-pengedar atau G peruncit-peruncit mereka yang berlesen akan dianggap suatu perihal dagangan yang palsu dalam lingkungan maksud Akta Perihal Dagangan 1972 DAN ADALAH DIPERINTAHKAN bahawa kos permohonan ini dan kos sampingan baginya dibayar oleh mana-mana pihak yang didapati melanggar hak cap dagangan tersebut.

H Parkson Corp Sdn Bhd ('Parkson') by way of a notice of motion dated 7 November 1994 (encl 10) prayed for the following orders:

(1) that Parkson be added as a respondent in this action and that the originating motion (it should be the 'notice of originating motion') be amended accordingly by naming Parkson as a respondent and the matters of this proceeding be amended to include s 45 of the Trade I Marks Act 1976;

(2) that Fazaruddin do within 10 days of the grant of this order serve on Parkson or its solicitors, Skrine & Co of Straits Trading Building, No 4, Leboh Pasar Besar, 50050 Kuala Lumpur, a copy of the ex parte

originating motion (it should be the 'notice of originating motion') dated 7 July 1994 together with copies of any affidavits and/or any documents exhibited to it or related to the originating motion (it should be the 'notice of originating motion');

(3) that Parkson as a respondent to this action be at liberty to:
  (a) apply to expunge the registration of the trade mark number 92/07141 in the name of Fazaruddin; and
  (b) set aside the order of this honourable court dated 7 July 1994 obtained by Fazaruddin in this action;
  (c) have the damages assessed by the registrar.

(4) that the costs of and occasioned by the application be costs in the cause; and

(5) such further or other orders as this honourable court thinks fit.

The notice of motion in encl 10 was supported by an affidavit of Yong Boon Sen (encl 9) affirmed on 1 November 1994 but was filed on 7 November 1994. On 14 January 1995, Mr Brian Komathi, learned counsel for Fazaruddin, conceded that prayers (1) and (2) of encl 10 should be ordered in favour of Parkson and orders to that effect were made by me as reflected in encl 23. The date for the hearing of prayer 3 of encl 10 was scheduled to be heard on 7 February 1995. In the meantime, Fazaruddin affirmed an affidavit in reply on 6 March 1995 as reflected in encl 13. By way of a reply, Parkson through Law Boon Eng affirmed an affidavit in reply on 2 May 1995 (encl 15) where Law Boon Eng adopted the contents of the affidavit of Yong Boon Sen in encl 9. Fazaruddin took swift action and filed an affidavit in reply to encl 15 affirmed on 29 June 1995 (encl 16). Parkson filed a further affidavit affirmed by Law Boon Eng on 7 December 1995 (encl 27) and Fazaruddin replied by way of affidavit affirmed on 19 January 1996 (encl 29).

By summons in chambers (encl 20) dated 19 August 1995 and supported by an affidavit of Law Boon Eng affirmed on 17 August 1995 (encl 19), Parkson sought to cross-examine Fazaruddin, Muthalib bin Kiman ('Muthalib') and Boo Ah Lek. Parkson also sought these personalities to be present and be cross-examined accordingly (prayers (1) and (2) of encl 20). By prayer (3) of encl 20, Parkson prayed:

> ... that unless the applicant (referring to Fazaruddin), Muthalib and Boo Ah Lek attend, their affidavits shall not be used as evidence by the special leave of the court.

In due course to be precise, on 30 September 1995, I granted prayers (1) and (2) of encl 20 and struck out prayer (3) of encl 20.

Fazaruddin through Mr Brian Komathi filed a summons in chambers dated 27 October 1995 (encl 25) to cross-examine both Yong Boon Sen and Law Boon Eng. Fazaruddin's application in encl 25 was supported by his own affidavit dated 13 October 1995 (encl 24). On 27 October 1995, I granted prayers (1), (2) and (3) of encl 25.

A For Parkson, only Law Boon Eng turned up to be cross-examined. It transpired that Yong Boon Sen had left Parkson and he would not be available to be cross-examined, yet Law Boon Eng under re-examination had the audacity to say that he would be adopting Yong Boon Sen's affidavit in encl 9 as his own.

B On the other hand, Fazaruddin and Muthalib were available for cross-examination and they were cross-examined. Boo Ah Lek was traced and was available but he was not cross-examined. Mr M Nathan, learned counsel for Fazaruddin, informed the court that he would not be relying on the statutory declaration of Boo Ah Lek as seen in exh F3 of encl 13.

C There was evidence that Fazaruddin registered himself as the proprietor of the 'ZIG ZAG' trade mark ('the mark') with the Registrar of Trade Marks on 9 October 1992 and his registered trade mark number was 92/07141 confined to articles of clothing; included in class 25.

The essential feature of the device is in regard to the words 'ZIG ZAG' in capital letters with the words 'QUALITY CLOTHING' in less D prominent print. The device includes the words 'RUGGED WEAR' in oval design with initials 'RW' placed against a dark background. Section 36 of the Trade Marks Act 1976 ('the Act') gives some leverage to Fazaruddin and it enacts that:

> E In all legal proceedings relating to a registered trade mark (including applications under s 45) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

It is common ground, as I said earlier, that Fazaruddin applied for and F obtained on 7 July 1994 a trade description order; and with that, he complained to the Ministry of Trade and Industry which then raided Parkson's premises on 20 September 1994 and confiscated the infringing goods that bore the mark.

Only three issues were ventilated before me as can be seen in prayers G 3(a), (b) and (c) of encl 10, namely:

(a) expungement of the registration of trade mark number 92/07141 in the name of Fazaruddin;

(b) setting aside the trade description order dated 7 July 1994; and

(c) damages to be assessed by the Registrar of the High Court.

H

The first and second issues

Parkson advanced an argument that they were aggrieved by the trade registration number 92/07141 registered with the Registrar of Trade Marks as it contravened s 14 of the Act. In short, Parkson too was interested in I the same trade mark as that used and registered by Fazaruddin. The relevant part of s 14 of the Act reads as follows:

> A mark or part of a mark shall not be registered as a trade mark:

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law. A

On deception and confusion, Parkson can be said to be 'the assiduous efforts of an infringer' — a phrase coined by Windeyer J in *Berlei Hestia Industries Ltd v Bali Co Inc* (1968) 118 CLR 128 at p 133. In *Dunn's Trade Mark* (1890) 7 RPC 311 at p 318, HL, Lord Macnaghten described the B underlying principles of deception and confusion in these words:

> Ever since courts of equity have interfered to protect traders in the exclusive use of marks and words, which they have lawfully appropriated for the purpose of distinguishing their goods, it has been an established principle that this protection is not to be extended 'to persons whose case is not founded in truth'. That is said to be 'a clear rule'. C
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> Unfortunately in the competition for business, a trader not infrequently endeavours to attract custom by representing that the goods which he offers for sale are different in origin, composition or character from what they really are. The public are constantly tempted to buy one thing when they think they are buying another. It is not, as has been observed, the province D of the court to protect speculations of this kind. Between rival traders the application of the principle is necessarily a matter of extreme difficulty. But as between the innocent public and a trader seeking registration of a proposed trade mark, there is, I think, no room for hesitation or doubt.

Lord Macnaghten proceeded further to say in *Dunn's Trade Mark* at p 319 that the tribunal should refuse to register 'words which involve a misleading E allusion or a suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood'.

Since Fazaruddin was on the register earlier than Parkson, the questions of deception and confusion occasioned by Fazaruddin in registering the mark do not arise at all. F

Section 3(1) of the Act defines 'mark' to include 'a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof'. The definition of the word 'mark' as can be seen is all encompassing. It is construed widely so that almost any visual feature added to goods may come within the definition. Thus, in *Smith Kline & G French Laboratories Ltd v Sterling-Winthrop Group Ltd* [1975] 2 All ER 578, HL, a colouring system applied to pharmaceutical capsules was held to be a mark. In *George Banham & Co Ltd & Ors v F Reddaway & Co Ltd & Anor* [1927] AC 406, HL, coloured lines running the whole length of a hosepipe were held to be a mark. It must be emphasized that when Fazaruddin registered the mark, he was earlier in point of time than Parkson and he H was the sole registrant for that mark. Parkson made no attempt to register the mark. There was oral evidence that there was a breakdown in communication between the merchandising department and the legal department of Parkson with the result that Parkson did not register the mark with the Registrar of Trade Marks. In 1994, according to Law Boon I Eng, there were other brands that were left out of registration. As a big business enterprise, Parkson was nowhere within the range of Fazaruddin's ability in the context of registering the mark. As a small time businessman,

Fazaruddin has the inherent right to protect the mark as his own. As a registered proprietor, Fazaruddin has 'the exclusive right to the use of the trade mark in relation to those goods subject to any conditions, amendments, modifications or limitations entered in the register' as enshrined in s 35(1) of the Act.

To succeed in expunging the registration of trade mark number 92/07141, Parkson must show that they are aggrieved by an entry made in the register without sufficient cause or by an entry wrongfully remaining in the register as envisaged under s 45(1)(a) of the Act. A person (other than the registered proprietor or the Registrar of Trade Marks) must be aggrieved by the registration of a trade mark before he can apply for its removal or variation. The phrase 'person aggrieved' in s 45(1)(a) of the Act should be construed liberally. In my judgment, it includes any person whose own application for registration is obstructed by the opposing party in the suit and extends to any person who is alleged to have infringed the registration. It also extends to anyone whose legitimate business may be adversely affected by a wrongful registration. As Lord Herschell said in the House of Lords in *Powell's Trade Mark* (1894) 11 RPC 4 at pp 7–8:

> Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which, but for the existence of the mark upon the Register, he could lawfully do, it appears to me that he has a locus standi to be heard as a person aggrieved.

Earlier on in the Court of Appeal in *Powell's Trade Mark* (1893) 10 RPC 195 (CA) at p 201, Bowen LJ said:

> Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that.

Now, the phrase 'in the same trade' as employed by Lord Herschell in *Powell's Trade Mark* was further expounded in the case of *Lever Bros Port Sunlight v Sunniwite Products Ltd* (1949) 66 RPC 84, which involved an infringement action where the defendants there sued for rectification by way of defence. Romer J boldly held that they were not persons aggrieved in respect of any registered goods which were not goods of the same description as those in which they traded themselves. His Lordship said this:

> ... the defendant's sole activity lies, and has lain for some years past, in the region of soapless detergents. This being so, and in the absence of some evidence to support the view, I am unable to see how they can sensibly be regarded as aggrieved in respect of the plaintiff's mark being on the register in relation to perfumery, cosmetic, preparations for the hair and dentifrices. I have already indicated my opinion that none of these productions are goods of the same description as soapless detergents.

It is a correct statement of the law to say that the court's powers to order rectification of the register and the expunging of a trade mark under s 45(1)(a) and (b) of the Act respectively are discretionary in nature. This is the natural and ordinary meaning of the words employed in this section and it promotes the underlying policy of the Act by investing in the court a sufficient degree of flexibility in order to give effect to public interest considerations. Thus, the existence of a discretion to withhold relief, even if a ground for rectification or removal has been made out, is now well settled by authority. On rectification, references may be made to *Hannaford & Burton v Polaroid Corp* [1976] 2 NZLR 14 at pp 17–18, PC; *General Electric Co v General Electric Co Ltd* [1972] 1 WLR 729 at p 751; *Berlei Hestia Industries Ltd v Bali Co Inc* (1973) 129 CLR 353 at p 363; *Imperial Group Ltd v Philip Morris & Co Ltd* (1982) 8 FSR 72 at pp 87–88; and in regard to removal, two cases may be referred to: the first would be *Re Carl Zeiss Pty Ltd's Application* (1969) 122 CLR 1, at pp 5–6 and the second is *Astronaut Trade Mark* [1972] RPC 655 at p 672. I hold and it is my judgment that the proper and correct approach under s 45(1)(a) and (b) of the Act would be this: that if the condition for the exercise of the court's power has been established, the entry of the mark should be expunged or the mark should be removed as the case may be.

Parkson through the affidavit of Yong Boon Sen in encl 9 sought to introduce evidence of usage. It was deposed by Yong Boon Sen that Parkson began using the mark in 1987 and that Parkson's approximate annual value of sales of its garments using the said mark came to a staggering figure calculated from December 1987 to June 1994. That figure was listed by Yong Boon Sen as follows:

Year		Value
December 1987–June 1988	.....	RM89,550
July 1988–June 1989	.....	RM245,963
July 1989–June 1990	.....	RM180,860
July 1990–June 1991	.....	RM1,374,244
July 1991–June 1992	.....	RM1,440,739
July 1992–June 1993	.....	RM1,081,253
July 1993–June 1994	.....	RM1,009,369

Sample copies of invoices from Parkson's various contract manufacturers of articles of clothing bearing the mark commencing 14 October 1987 were exhibited and marked as exh P2. Sample copies of advertisements for clothing bearing the same mark were also exhibited and Yong Boon Sen deposed that they had samples as far back as 1987, but on careful scrutiny the advertisements went only as far back as 24 February 1989 (see p 38 of exh P3 in encl 9). Parkson was said to have incurred expenses and had spent a considerable amount of money for promoting and advertising their 'ZIG ZAG' brand of clothing. The breakdown figure in typewritten form

was exhibited as P7 and it is interesting to note that the earliest date shown in that typewritten form was 10 June 1989. All in, the advertising expenses incurred by Parkson amounted to RM142,158.30. Yong Boon Sen deposed further that the extensive sales and promotional exercises by Parkson had made the mark distinctive and referable to Parkson and no one else. The 'ZIG ZAG' device was not distinctive to Fazaruddin, so said Yong Boon Sen in his affidavit. The registration of the mark by Fazaruddin was said to offend s 14 of the Act. What was of crucial importance was the averment by Yong Boon Sen in encl 9 to the effect that Parkson 'is the common law proprietor of the "ZIG ZAG" mark with an oval device containing the words "Rugged Wear" which mark was designed/conceived in-house'. Unfortunately, Fazaruddin was not accorded the opportunity of cross-examining Yong Boon Sen and this greatly impeded Fazaruddin.

Law Boon Eng as a merchandising manager for Parkson affirmed an affidavit-in-reply for Parkson (encl 15) and conveniently adopted the affidavit of Yong Boon Sen (encl 19) as his own. Law Boon Eng deposed that once a trade mark certificate was issued, the date of registration will be taken to be the date of the filing of the trade mark application and that date would be 9 October 1992 — indeed, this was the date of the registration of the mark by Fazaruddin as reflected in exh C of encl 3. As demonstrated earlier, the proprietor of a registered trade mark like Fazaruddin, has certain rights which arise out of his registration. Principal among these, and in fact the foremost, is the exclusive right to use the mark in relation to the goods (if I may add, it may even extend to services) once it is registered. This means that Fazaruddin has the right to exclude the use of the mark by others. Anyone who does so without Fazaruddin's consent infringes that right and certainly can be sued in court (see s 35(1) of the Act). I hasten to add that registration of a trade mark is not compulsory in our country. Thus, we can envisage a situation where the owner of an unregistered mark may use that mark commercially or otherwise but he certainly cannot sue for infringement (see s 82(1) of the Act). This inability or impediment to initiate any action for infringement of an unregistered mark applies even if registration has been applied for but the application is still pending notwithstanding the fact that under s 30(1) of the Act, the date of application shall be deemed to be the date of registration if the mark is eventually registered. That this is so stems from the very liberal definition of a registered trade mark in s 3(1) of the Act to mean a trade mark 'which is actually upon the register'. Reverting to encl 15, Law Boon Eng deposed further that the trade description order dated 7 July 1994 was too broad as it did not identify the infringing mark and as such was invalid and should be set aside. It was said that Parkson, which owned and operated a large and highly reputable chain of departmental stores throughout the country, would not resort to knowingly and fraudulently using someone else's trade mark. Parkson denied that Fazaruddin had suffered any damage as alleged and it was Law Boon Eng's assertion that Parkson sold its clothing in departmental stores throughout the country as compared to Fazaruddin whose main customers were confined to the 'pasar malam' markets. Of crucial importance was an assertion by Law

Boon Eng that Parkson was an honest concurrent user of the mark and was not aware of any prior use of the mark at all material times. A

In encl 27, Law Boon Eng affirmed an affidavit dated 7 December 1995 and there he deposed that he had been the merchandising manager for Parkson since October 1988 and was the supervisor of Yong Boon Sen who had since left Parkson's employment. Law Boon Eng also deposed B that the contents of Yong Boon Sen's affidavit (encl 9) were within his own personal knowledge or from Parkson's records and consequently, Law Boon Eng was in a position to confirm and adopt the contents of the affidavit of Yong Boon Sen in these proceedings. To show that Parkson was connected with the mark, a local purchase order from Natvest Sdn Bhd (the previous name of 'Parkson') dated 10 November 1987 was C exhibited as 'LBE 2'.

Law Boon Eng further deposed in encl 27 that sometime in 1991/1992, the mark underwent some transformation as reflected in exh LBE 3.

Law Boon Eng also deposed in encl 27 that the words 'Rugged Wear' in an oval device as registered by Fazaruddin were derived from an D American company sometime in early 1992.

Law Boon Eng took the stand and he was referred to encl 19 (exh LBE1) and he categorically said that by resolution of the Board of Directors, he was authorized to affirm the affidavit and give evidence for Parkson based on the company's records and his own personal knowledge. E When shown encl 27 para 3, he remarked that as a merchandising manager for Parkson since October 1988, he had supervised Yong Boon Sen, who had since left Parkson, and verily he said that the affidavit of Yong Boon Sen in encl 9, especially its contents, were within his own personal knowledge or from Parkson's records and he was thus in a position to confirm and adopt the contents of encl 9. Law Boon Eng testified further F that he agreed with the prayers that were sought in encl 9 when shown two invoices at pp 25 and 26 of encl 9 that carried the names of 'Natvest Sdn Bhd', Law Boon Eng was quick to reply that that was the original name of Parkson which name was then changed to 'In View Sdn Bhd' before adopting its present name. In short, all the sample invoices exhibited in G encl 9 were agreed to by Law Boon Eng. The sample advertisements in encl 9 were also agreed upon by Law Boon Eng and the latter further agreed that mark 'B' of exh LBE 2 of encl 27 was a representation of the mark of Parkson on 10 November 1987. In 1991/1992, according to Law Boon Eng, the 'Zig Zag' mark went into some form of transformation as H reflected in mark 'B' of encl 27. In 1992, Parkson was said to have switched to using the label as reflected in exh P1 of the affidavit of Yong Boon Sen in encl 9. It is germane at this juncture to make an observation that exh P1 was exactly like mark 'A' — the trade mark registered in the name of Fazaruddin on 9 October 1992. Thus, while Parkson started using mark 'A' in 1992, Fazaruddin had advanced manifold by registering I mark 'A' on 9 October 1992 as his own. Law Boon Eng agreed in examination-in-chief that on 20 September 1994, officers from the Ministry of Domestic Trade and Consumer Affairs raided eight of Parkson's stores

in pursuance of the trade description order dated 7 July 1994. Again, when shown the affidavit of Yong Boon Sen in encl 9, Law Boon Eng agreed that the advertising expenses incurred by Parkson as shown in exh P7 were mere estimates.

Under cross-examination, Law Boon Eng was shown the affidavit of Yong Boon Sen in encl 9, especially para 2, and he categorically said that he was not the designer nor the creator of exh P1 — meaning he did not design nor create a mark like mark 'A'. Law Boon Eng too said that he did not know the person who designed and created the mark like mark 'A' as used by Parkson. However, Law Boon Eng had the audacity to say that he was absolutely certain that the mark like mark 'A' was not being used by anyone else before Parkson began using it. However, Law Boon Eng agreed that he was not certain and had no knowledge whether the mark like mark 'A' was being used by other parties prior to 1992, the date when Parkson started using the mark like mark 'A'.

Law Boon Eng testified that he was not employed by Parkson at the time the design or logo was created and consequently, he had no personal knowledge of the design and creation of the logo. In 1987, when Parkson started using the logo, Law Boon Eng was not in the employment of Parkson and the details in para 3 of encl 9 must have been incorporated by relying solely on the records of Parkson. It was put to Law Boon Eng that at no time did Parkson make an attempt to register the logo prior to the raid by officials from the Ministry of Trade. Initially, Law Boon Eng replied that he agreed that the logo was not registered prior to the raid but a short while later he relented and remarked that 'we have no idea whether the trade mark was registered, we assumed that it was registered'. A crucial question was advanced in the course of cross-examination of Law Boon Eng. It was this:

> When the applicant Fazaruddin applied for the mark/design logo to be registered and in accordance with proper procedure and when it was advertised in the *Gazette* by the Ministry of Trade, did Parkson not file any notice of objection within the two months' period?

The answers were these:

> The information were not available to us and we have no knowledge.
>
> How can I lodge an objection to the Ministry since I have no knowledge?
>
> I affirm that I do not make an objection because I do not know.

Law Boon Eng agreed that Parkson's approximate annual value of sales of its garments as reflected in para 3 of encl 9 was not prepared by him and those figures could not be verified by exh P2 of encl 9 as exh P2 was said to be representative samples of the invoices. The figures of the annual value of sales were said to be a summary of sales reports and Law Boon Eng admitted that he was not involved at all in the preparation of these figures and had no personal knowledge thereof. At the same time Law Boon Eng was not prepared to contradict Yong Boon Sen's averment in encl 9. It was put to Law Boon Eng and he disagreed that the sums incurred in advertisements were meant for the promotion of Parkson and

not the mark. Law Boon Eng also disagreed that the costs of advertisements for the mark were proportionately small. However if one were to take a closer look at p 33 of exh P3 as reflected in encl 9, one would immediately detect the words 'ZIG ZAG' in small print and on the same page other products sold by Parkson were also highlighted. This gives the impression that p 33 of exh P3 in encl 9 and in fact all the other advertisements were not solely meant nor confined to the mark but also gave prominence to the other products sold by Parkson. Law Boon Eng emphasized that sales were conducted two to three times per year and during this period slow-moving items would be sold at normal prices. Of pertinence would be Law Boon Eng's assertion that the merchandise were discounted store-wide and the 'ZIG ZAG' product was one of them. Law Boon Eng reiterated that Parkson was an honest concurrent user of the mark and was not aware of any prior use of the said mark at all material times. When shown encl 27 para 6, Law Boon Eng remarked that Parkson copied the design from an American company sometime in 1992.

Under re-examination, Law Boon Eng testified that as a merchandising manager for Parkson since 1988, one of his duties was to approve or reject new labels or trade marks. He ventured to say that Parkson created other trade marks other than the 'ZIG ZAG' by the in-house unit. He was categorical that in 1988 the mark was already with Parkson. Law Boon Eng testified that it was a company policy that before a trade mark was used, a search would be conducted by the legal department and once the search confirmed availability of that mark, Parkson would then start production. Indeed, if this was so, the legal department of Parkson would not have wasted precious time, it would have registered the mark with the Registrar of Trade Marks in 1988. But alas, this was not the case. As stated in the early part of this judgment, the breakdown in communication between the merchandising and legal departments resulted in the failure of Parkson to register the mark. Law Boon Eng was cautious when he said that he was not well-versed with the trade mark application procedure and he was not aware of the opposition period to challenge the application for registration. When shown p 33 of encl 9, Law Boon Eng remarked that the male model as shown in the print-out was wearing clothes with the trademark. Law Boon Eng testified further that he was Yong Boon Sen's superior and he was in a better position to testify on behalf of Parkson. He said that Yong Boon Sen was with Parkson for only two years. Finally, Law Boon Eng testified that he would adopt Yong Boon Sen's affidavit in encl 9 as his own.

Fazaruddin affirmed several affidavits. In his affidavit in encl 3 affirmed on 7 May 1994, he deposed, inter alia, the following facts:

(1) He carried on business under the style of Perniagaan Fatama and had it registered with the *Kementerian Perdagangan dan Perindustrian* on 30 October 1992 and with the Pendaftar Perniagaan, Semenanjung Malaysia on 26 January 1994.

(2) He registered the mark with the Registrar of Trade Marks on 9 October 1992 and was given a trade mark No 92/07141.

A (3) He used the mark on articles of clothing and textiles.

In his further affidavit in encl 5 that was affirmed on 5 July 1994, Fazaruddin deposed, inter alia, that:

(1) On 7 April 1994, he visited Parkson's premises at Holiday Plaza, Jalan Dato' Sulaiman, Johor Bahru and found his registered 'ZIG ZAG' B trade mark as reflected in mark 'A' being widely used by Parkson on articles of clothing that were meant for sale.

(2) He did not at any time receive an application from Parkson to use his registered the mark and neither did he give his consent to Parkson to use the same.

C (3) He purchased a shirt from Parkson which clearly carried his registered the trade mark on 7 April 1994 vide receipt No 00866 1040013.

(4) He took photographs within Parkson to show that his registered mark was used on articles of clothing exhibited for sale by Parkson.

By way of an affidavit-in-reply (encl 13) affirmed on 6 March 1995, D Fazaruddin deposed as a registered proprietor of the mark and owner of 'Perniagaan Fatama' to the following effect particularly in reference to Yong Boon Sen's affidavit in encl 9:

(1) He is the common law user and registered proprietor of the mark as reflected in mark 'A'. He was inspired to create the mark while working with Bandartex Textiles Sdn Bhd at Batu Pahat ('Bandartex') between E 1981 till 1983 — which job entailed printing of logos on articles of clothing.

(2) In 1984 he was inspired to create the mark as reflected in mark 'A' while working at Bandartex. Initially he said he coined the words 'ZAG ZIG' but because of the peculiarity in its sound, he altered it to 'ZIG F ZAG' in 1984 itself. The words 'Rugged Wear' were inspired through the production of children's apparel at Bandartex.

(3) In due course, he combined the words 'ZIG ZAG' with that of 'Rugged Wear' and it became the trade mark as seen in mark 'A' This was in 1984. He used that logo as reflected in mark 'A' to articles of clothing since 1984.

G (4) In 1984, he stopped working for Bandartex and worked for a company known as 'Ekikon'. He also did part-time work by printing 'ZIG ZAG' mark on T-shirts and sold his products at night markets in and around Batu Pahat area. He deposed that two of his colleagues, namely, Muthalib and Boo Ah Lek assisted him in printing the mark on the T-shirts. Both Muthalib and Boo Ah Lek swore a surat akuan each. For H this exercise, it is appropriate to refer to Muthalib's 'surat akuan' only as Boo Ah Lek was not cross-examined at all. Muthalib's 'surat akuan' was short; it contained two paragraphs and was worded thus:

'(1) Bahawa saya dengan ini telah mencetak pakaian bernama 'ZIG ZAG' bersama-sama rakan saya di rumah di Jalan Lian Yen Leong, Batu Pahat (di halaman rumah) pada tahun 1984 dan 1985.

I (2) Saya juga mengaku dan mengesahkan bahawa saya mencetak sebanyak lebih kurang 10 dozen pakaian T-shirt pada tahun 1984 dan 10 dozen pakaian T-shirt pada tahun 1985.'

(5) In 1985 he stopped working for Ekikon and during the night he worked part-time at the night market selling his products assisted by his friends.

(6) In 1986 he applied to the Kementerian Perdagangan Dalam Negeri by letter dated 23 January 1986 to register his 'ZIG ZAG' mark as reflected in exh F4 and this letter was worded thus:

'23 Januari 1986
Fazaruddin bin Ibrahim,
23 Jalan Besi,
Kampong Kenangan Dato' Onn,
Batu Pahat, Johor

Pengurus,
Kementerian Perdagangan Dalam Negeri,
Tingkat 23, Menara Mayban,
100 Jalan Tun Razak,
Kuala Lumpur.

Tuan,

Per: Permohonan untuk memohon Cap Dagangan 'ZIG ZAG'

Berhubung dengan perkara di atas saya dengan sukacitanya ingin mendaftarkan cap dagangan jenama saya 'ZIG ZAG' di dalam cap dagangan yang sah. Saya ingin juga memohon pihak Kementerian menyemak sama ada jenama saya ini ada didaftarkan oleh seorang atau syarikat. Untuk pengetahuan tuan, saya tidak begitu arif dalam mengelolakan permohonan ini dan memohon kerjasama pihak tuan untuk membantu saya.

Di sini ada saya sertakan contoh logo/jenama 'ZIG ZAG' dan sampul surat berserta setem untuk mendapatkan borang pendaftaran.

Sekian, terima kasih.

Yang benar,

tt
Fazaruddin bin Ibrahim

Stamped Mark of
Kementerian
Perdagangan
dated 26 January 1986'

In the course of the trial, the original letter was tendered and marked as exh P2 when Fazaruddin was being cross-examined:

(7) A follow up was made where Fazaruddin attended the office of the Kementerian Perdagangan dan Perindustrian to ascertain whether his application was in order and enquire as to the registration of the mark. Fazaruddin was advised to be patient as the registration would take time. The patience paid off when on 9 October 1992 the mark was registered in his name.

(8) He said that Parkson had used his registered 'ZIG ZAG' trademark and profited from it. He did not know and was in total darkness and sought

Parkson to prove the invoices and advertisements exhibited in encl 9 of Yong Boon Sen's affidavit. He denied that he had wrongly and/or fraudulently registered the mark in his name and put Parkson to strict proof thereof.

(9) He categorically stated that he had used the mark since 1984 and he exhibited several invoices which were translated and the earliest date showed 26 March 1985.

(10) He denied knowledge of the expenses incurred by Parkson for promoting and advertising the 'ZIG ZAG' brand of clothing and put Parkson to strict proof thereof.

(11) He denied the assertion by Parkson that through sales and promotion the mark became distinctive and referrable to Parkson and no one else. He categorically stated that he was a common law user and the registered proprietor of the mark; it was Parkson that fraudulently used the mark and caused Fazaruddin to experience losses.

As demonstrated, encl 13 of Fazaruddin's affidavit was a point by point reply to Yong Boon Sen's affidavit in encl 9.

Fazaruddin's affidavit in encl 16 was a reply to Law Boon Eng's affidavit in encl 15. In encl 16, Fazaruddin, inter alia, deposed that:

(1) He relied on his affidavit in encl 13 that was affirmed on 6 March 1995.

(2) He said that the use of the mark was not confined to small towns in the vicinity of Johor Bahru but its usage extended to the whole of Malaysia.

(3) He said (that part which is relevant to this exercise) that the surat akuan of Muthalib should be admissible in court.

(4) He disagreed that the trade description order dated 7 July 1994 was too broad and did not identify the infringing mark. He held the view, rightly so, that the trade description order dated 7 July 1994 was legally valid. He was of the view as agreed by Yong Boon Sen that the several raids conducted by the *Kementerian Perdagangan dan Hal Ehwal Pengguna* were strictly conducted in compliance with the law.

(5) He categorically stated that there was no fraud demonstrated by him when he said that he was the registered proprietor of the mark.

(6) He categorically stated that Parkson had used his registered the mark as evident from exhs P4 and P5 of Yong Boon Sen's affidavit in encl 9 where articles of clothing which bore the mark were seized by the officers during the raid on Parkson's premises.

(7) It was an assertion by Fazaruddin that he sustained losses as a result of Parkson using his registered 'ZIG ZAG' trade mark. He denied that Parkson was a concurrent user of the mark.

On 19 January 1996, Fazaruddin affirmed an affidavit-in-reply (encl 29) to rebut the affidavit of Law Boon Eng (encl 27). Fazaruddin put Parkson to strict proof in regard to paras 3, 4, 5 and 6 of encl 27 which had been amply set out in the early part of this judgment. It was deposed by Fazaruddin in encl 29 that he purchased leather jackets from Singapore for eventual transmission and sale in Kuala Lumpur. He also allowed Pusat Fesyen Dors to sell articles of clothing bearing the mark. He said that he purchased 3,000 leather jackets from Action Gear Sdn Bhd worth

RM360,000 for distribution throughout Malaysia in January 1993 and a copy of the letter from the company was exhibited as exh F13. These pieces of evidence were all meant to show that Fazaruddin's business was not small and was not confined to the night market at Batu Pahat. He also said that he gave permission to Fastino Sdn Bhd to use his registered 'ZIG ZAG' trade mark.

Just like Law Boon Eng, Fazaruddin took the stand and he gave evidence in a straightforward manner. Under examination-in-chief, Fazaruddin's evidence may be summarized as follows:

(1) He was the sole proprietor of Perniagaan Fatama.

(2) The original purpose of creating the mark was to enter the logo competition organized by Bandartex in 1983 and 1984. He won third place in the competition.

(3) He had, since 1985, used the mark for his business. At the sports meet organized by Bandartex he used the mark without the words 'Rugged Wear (RW)' and 'Quality Clothing'.

(4) In 1985, 1986 and early 1987 he sold articles of clothing bearing the registered 'ZIG ZAG' mark in night markets. This continued in 1992 till now.

(5) He said he used the mark in 1983 and when he sold articles of clothing in 1985 he used the same mark. He elaborated that he sold his articles of clothing bearing the mark not only in night markets but also in departmental stores like Pertama Complex in Kuala Lumpur and shopping complexes in Pulau Pinang.

(6) He categorically stated that all his affidavits were correct and true.

Under cross-examination, Fazaruddin had this to say:

(1) In 1984 when he entered the competition at Bandartex he utilized the registered 'ZIG ZAG' mark as reflected in mark 'A'.

(2) He designed mark 'A' in 1984.

(3) As proof that he designed mark 'A' in 1986, he tendered 'satu gulung label "ZIG ZAG"' which was in due course marked as exh R3. It must be borne in mind that there was nothing to show on the 'satu gulung label "ZIG ZAG"' that it was made in 1986.

(4) He was not able to tender proof that he designed the 'ZIG ZAG' mark in 1984 as he had sold all the clothes bearing the mark. He went on further to say that he designed the mark in 1983 but he only used it in 1984. He re-emphasized the factual situation by saying that in 1983 he merely had the words 'ZIG ZAG' in mind and in 1984 he designed the logo in detail as reflected in mark 'A' and used the same for the sports meet at Bandartex.

(5) He said that he manually made mark 'A' without the aid of a machine.

(6) He said that the leftovers from the sports meet were sold by him at night markets. Though he said that there was an invoice for 1984, yet a perusal of encl 13 (exh F8) merely showed the earliest date to be 26 March 1985.

(7) In 1984, 1985 and 1986 when he sold the articles of clothing bearing the mark in night markets at Batu Pahat, he utilized his auntie's licence for that purpose. This cross-examination was aimed at discrediting Fazaruddin. As a hawker, Fazaruddin was bound by the Hawkers (Majlis Daerah Batu Pahat Timur) By-Laws 1981 ('Hawkers By-Laws'). Section 3 of the Hawkers By-Laws states that no person shall act as a hawker without a licence issued by the president under these by-laws. Section 10(1) of the Hawkers By-Laws states that a licence shall not be transferable. Section 22 of the Hawkers By-Laws lays down the penalty for non-observance and it states that any person who acts as a hawker without a licence issued by the president under these by-laws and any person who being licensed by the President under these by-laws acts in contravention of any of the provisions of these by-laws shall be guilty of an offence and shall be liable on conviction to a fine not exceeding RM1,000. It is clear the Fazaruddin was an illegal hawker under the Hawkers By-Laws. But this does not affect his sole proprietorship of the mark.

(8) A question was posed to the effect that Parkson had used the mark in 1987 in a big way and had advertised in newspapers throughout Malaysia without objections by Fazaruddin until the enforcement officers raided Parkson. Fazaruddin replied that he did not know this fact. It is interesting to note that Law Boon Eng in his several affidavits did not depose that Fazaruddin did not object to the advertisements of the mark in the newspapers throughout Malaysia and it is apparent that this method of questioning was meant not only to cloud the issue but also to confuse Fazaruddin.

Under re-examination, Fazaruddin testified and reiterated the same set of facts. It was at this stage that the 'segulung label which he sold in 1986' was marked as exh R3. He identified Muthalib as his witness who saw him make exh R3. He agreed that before 23 October 1992, he carried out his business without being registered. The original invoices for the 'ZIG ZAG' mark products were marked as exh R4.

Muthalib was the last witness called to the stand by Fazaruddin for cross-examination.

Under examination-in-chief, Muthalib agreed to the contents of his 'surat akuan'. He testified that at the time he was working at Soultex (should be spelt as 'Soutex') as a printer. Fazaruddin too, according to him, was working there. He said that he worked there from 1981 to 1984 and he knew that Fazaruddin participated in the logo competition. At that time, Rahim was the supervisor of Soultex (should be spelt as 'Soutex') and his name can be seen at exh F1(B) of encl 13.

Under cross-examination, Muthalib said that Fazaruddin was his good friend and they had known each other since school days. He said that there was an 'alat cetak' for the 'ZIG ZAG' and that the 'alat cetak' would be placed on a long chair at a house located at Jalan Lian Yeng Leong, Batu Pahat which house belonged to his friend by the name of Suleiman. He testified that it was at this house that the printing was done and that Suleiman was not involved at all. White T-shirts were used and in 1986, about 10 dozen (120 pieces) T-shirts were printed. He said that he helped

Fazaruddin in printing the T-shirts and that there were two others who had helped but he had forgotten their names. Fazaruddin assisted in arranging the T-shirts. The size of the 'pencetak' was about 1½ feet by 1 foot. Muthalib further testified that they printed 10 dozen (120 pieces) 'ZIG ZAG' products by the end of 1984 for sports purposes and these products were not meant for sale. It required four people to print the mark. After printing they had to dry them. In 1984, there were 100 participants in the sports meet. It was only in 1985 that Muthalib assisted Fazaruddin to print the mark on T-shirts for sale. Ten dozen (120 pieces) were printed over a duration of four months in 1985. The printed T-shirts were then sold in night markets at Batu Pahat twice a week. Muthalib was unable to remember for how long Fazaruddin sold the T-shirts by himself. He had forgotten the price of each T-shirt. He assisted in printing and the marketing was done by Fazaruddin. He knew A Rahim as his supervisor and that gentleman was not present in court today. Muthalib understood the implication of the 'surat akuan'.

There was no re-examination of Muthalib.

I have set out the evidence in some detail so that the perspective of the whole case can easily be seen. I will now consider the issues that surfaced from the affidavits and the oral testimony of the witnesses.

Common law user of the trade mark

The basic common law principle is this: the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark (*Re Registered Trade Mark 'Yanx', ex p Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199 at p 203; *Thunderbird Products Corp v Thunderbird Marine Products Pty Ltd* (1974) 131 CLR 592 at p 603; *Moorgate Tobacco Co Ltd v Philip Morris Ltd (No 2)* (1984) 59 ALJR 77 at p 83). It is said that a person who becomes proprietor of a trade mark in this way is entitled at common law to restrain a person who later commences to use the trade mark.

In *General Electric Co v General Electric Co Ltd* [1972] 2 All ER 507, Lord Diplock dealt at length with the history of trade marks in England both at common law and under statute and referred to the acquisition of property in a trade mark by use and its loss by disuse. In regard to the Trade Marks Act 1905 (UK), Neville J had this to say in *Re Kenrick & Jefferson Ltd's Application* (1909) 26 RPC 641 at p 649:

> It appears to me on the construction of the Act itself, that the effect of it is by no means to ignore the right of ownership of a trade mark, which has been acquired by user, although there is a prohibition against the recovery of damages, or the prevention of infringement prior to registration.

It has also been said that the use need not be one extending over a great length of time. On this point reference may be made to the case of *Hall v Barrows* (1863) 32 LJ Ch 548, where Lord Romilly MR said at p 551:

> It has sometimes been supposed that a manufacturer can only acquire such a property in a trade mark as will enable him to maintain an injunction against the piracy of it by others, by means of a long continued use of it, or, at least, such a use of it as is sufficient to give it a reputation in the market where such goods are sold. But I entertain great doubt as to the correctness of this view of the case. The interference of a court of equity cannot depend on the length of time the manufacturer has used it. If the brand or mark be an old one, formerly used, but since discontinued, the former proprietor of the mark undoubtedly cannot retain such a property in it, or prevent others from using it: but, provided it has been originally adopted by a manufacturer, and continuously, and still used by him to denote his own goods when brought into the market and offered for sale, then I apprehend, although the mark may not have been adopted a week, and may not have acquired any reputation in the market, his neighbors cannot use that mark. Were it otherwise, and were the question to depend entirely on the time the mark had been used, or the reputation of it had been acquired, a very difficult, if not insoluble, inquiry would have to be opened in every case, namely, whether the mark had acquired in the market a distinctive character denoting the goods of the person who first used it.

Applying the principles as distilled from these cases, Fazaruddin can be said to be the common law user of the mark even though under him the mark did not acquire a reputation in the market or, for that matter, a distinctive character. All too frequently, the exercise of judgment as to whether a mark is distinctive would entirely be an exercise of discretion: *Yorkshire Copper Works Ltd v Registrar of Trade Marks* [1954] 1 All ER 570 at p 572; [1954] 1 WLR 554 at p 558; (1954) 71 RPC 150 at p 154, HL; *Smith Kline & French Laboratories Ltd v Sterling-Winthrop Group Ltd* [1975] 2 All ER 578 at p 586; [1975] 1 WLR 914 at p 922; [1976] RPC 511 at p 539, HL. Fazaruddin confined his products using the mark to the night markets in the Batu Pahat area and later he branched out to Kuala Lumpur and Pulau Pinang. It was in evidence that Fazaruddin authored the mark as reflected in mark 'A' in 1984. On the other hand, Parkson through Yong Boon Sen sought to show that they were associated with the mark as far back as 1987 but unfortunately a close scrutiny of the advertisements which were exhibited in encl 9 showed Parkson's involvement on 24 February 1989 — a date which was much later than Fazaruddin's. Yong Boon Sen's affidavit in encl 9 was not tested by cross-examination as compared to Fazaruddin whose several affidavits were dissected when Fazaruddin took the stand in the witness box. Though Law Boon Eng deposed that he relied on Yong Boon Sen's affidavit as his own, in particular the contents of Yong Boon Sen's affidavit, the fact remains that Fazaruddin was deprived of cross-examining Yong Boon Sen in the witness box.

In examination-in-chief, Law Boon Eng sought to repair the affidavit of Yong Boon Seng especially that part which showed 24 February 1989 as the date where Parkson was involved in the mark. This was what Law Boon Eng said.

That mark 'B' of exh LBE2 of encl 27 was a representation of the mark of Parkson as at 10 November 1987. (I must say that if one looks at

mark 'B', it is different from mark 'A'. In mark 'B', the words 'ZIG ZAG' were written stylishly and there was written within a strip of dark background the words in capital letters, 'Fun Casuals'.) In 1991 or 1992 the mark was transformed and it took the shape of mark 'C', which was clearly different from mark 'A'. Finally, it was in 1992 that Parkson adopted mark 'A' as their own even though on 9 October 1992 Fazaruddin was the legal registered proprietor of mark 'A'.

In my judgment, applying the common law principle, Fazaruddin was the first person to use the mark on a small scale basis and he must therefore be the proprietor of that mark. Of course, as a common law proprietor, Fazaruddin was not entitled to restrain a later user who was an honest concurrent user of the same trade mark. An example of this situation would be this: a person who innocently commences to use the trade mark, unaware that this infringes the proprietor's right is said to be an honest concurrent user. At common law, neither the proprietor nor the honest concurrent user could restrict the other from using the trade mark, but each could restrain the usurper who used the mark: *GE Trade Mark* [1973] RPC 297.

Concurrent user

The crucial question to pose would be this: was Parkson an honest concurrent user of the trade mark as reflected in mark 'A'? From the recital of the facts, there was evidence that only in 1992, Parkson progressed ahead and started to use mark 'A', the very trade mark which Fazaruddin authored in 1984. The substantial similarity between the mark as used by the Parkson in 1992 and that authored by Fazaruddin in 1984 gave rise to a prima facie inference that Parkson copied Fazaruddin: *Re AUVI Trademark; AUVI Pte Ltd v Seah Siew Tee & Anor* [1992] 1 SLR 639. To put it bluntly, Parkson was a dishonest concurrent user of mark 'A'.

In statutory form s 20 of the Act, which is on concurrent use, enacts as follows:

> 20 (1) Notwithstanding sub-s(1) of s 19, in the case of honest concurrent use or of the circumstances described in para (c) of sub-s(4) of s 6 or of other special circumstances which, in the opinion of the court or the registrar, make it proper so to do, the court or the registrar may permit the registration of trade marks which are identical or so nearly resembling each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions, amendments, modifications or limitations, if any, as the court or the registrar, as the case may be, may think right to impose.
>
> (2) The registrar shall not refuse to register a trade mark which is identical to or so nearly resembling another trade mark in the register if the applicant of the first-mentioned trade mark of his predecessor in business has continuously used that trade mark from a date before:
>
> (a) the use of that other trade mark by the registered proprietor or his predecessor in business or by a registered user; or

A (b) the registration of that other trade mark by the registered proprietor or his predecessor in business;

whichever is the earlier.

Section 20(1) of the Act covers, inter alia, the situation of an honest concurrent user, of which Parkson is not one, and the court is given a wide B discretion to permit the registration of trade marks which are identical subject to such conditions, amendments, modifications or limitations which the court may think fit to impose. Since I have held that Parkson was a dishonest concurrent user, s 20(1) of the Act cannot be invoked to assist them. Parkson too cannot seek the aid of s 20(2) of the Act because they C used mark 'A' only in 1992 as opposed to Fazaruddin who had authored it in 1984.

Parkson put their case on the ground that the use of the mark as reflected in mark 'A' would be likely to deceive or cause confusion to the public contrary to s 14 of the Act. The test of deceiving or causing confusion was discussed by Lord Upjohn in *Berlei (UK) Ltd v Bali Brassiere* D *Co Inc* [1969] 1 WLR 1306; (1969) RPC 472; [1969] 2 All ER 812 where he said at pp 827–828:

> What, then, is the test? This must necessarily be a question of fact and degree in every case. I am content in amplification of the test laid down by Evershed J to take the test as in effect laid down by Romer J in *Re Jellinek's Application.* E It is not necessary in order to find that a mark offends against s 11 to prove that there is an actual probability of deception leading to a passing-off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court F has to be satisfied not merely that there is a possibility of confusion, it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register. And so mutatis mutandis when it is sought to expunge a mark.

In my judgment, confusion would be likely to prevail if Parkson was G allowed to register the mark like mark 'A' as Fazaruddin was, in point of time, already on the register. There would be a strong likelihood of confusion if articles of clothing bearing the same trade mark were put on the market. I hold and it is my judgment that the trade mark no 92/07141 should be allowed to remain on the register and it should not be expunged and further that the trade description order dated 7 July 1994 should H remain and not be set aside.

The House of Lords in the case of *GE Trade Mark* [1973] RPC 297 considered the issues of deception and confusion at some length. It would be germane to quote some passages from the judgment of Lord Diplock in *GE Trade Mark* especially at p 321 to this effect:

I > Where the question of the likelihood of deception or confusion arises upon an application to expunge a registered mark which has already been the subject of substantial issue, the absence of evidence of actual confusion

> having occurred is a potent factor in determining whether or not the court should exercise its discretion to expunge the mark from the register. But it does not decide the relevant hypothetical question which must be answered in the affirmative before any question of discretion to expunge the mark arises: would any normal and fair future use of the mark, in the course of trade, be likely to cause deception or confusion? If actual confusion in the past is proved, this is a strong indication that continued confusion is likely; but the absence of evidence of past confusion may be accounted for by the small extent to which the mark has been used or by special circumstances affecting its past use which may not continue to operate to prevent confusion in the future.

On the same page of the judgment, Lord Diplock continued:

> But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a 'jury question'. By that I mean that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

In another paragraph of the same judgment, Lord Diplock said this:

> The question does not cease to be a 'jury question' when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.

I am constrained to hold, and it is my judgment, on the facts of the present case, that firstly, there was no evidence of actual confusion having occurred by allowing the mark to remain on the register to enable me to exercise my discretion to expunge that mark from the register. Secondly, applying the common law usage, Fazaruddin was the first person to use the mark. Thirdly, as a registered proprietor of the mark as reflected in mark 'A', Fazaruddin has the exclusive right to use that mark. It has been said that registration asserts a title against the world: *Re Joseph Crosfield & Sons Ltd* [1910] 1 Ch 130, (1910) 26 RPC 837, CA ('Perfection'); *Re California Fig Syrup Co* [1910] 1 Ch 130, (1910) 26 RPC 846, CA ('California Syrup of Figs'); *Registrar of Trade Marks v W & G Du Cros Ltd* [1913] AC 624, (1913) 30 RPC 660, HL. Fourthly, there was no evidence to show that the entry on the register was an entry made without sufficient cause as to entitle this court to expunge it as it thinks fit.

Fraud

It was Parkson's stand that as a reputable chain of departmental stores they would not resort to knowingly and fraudulently using Fazaruddin's trade mark.

On his part, Fazaruddin denied that he had wrongly and/or fraudulently registered the mark in his name and categorically put Parkson to strict proof thereof. It is a correct statement of the law to say that neither law nor equity would assist a fraudulent trade: ex turpi causa non oritur actio (no right of action arises from a bad cause). In *Scott v Brown Doering McNab & Co* [1892] 2 QB 724 at p 728; [1891–94] All ER Rep 654 at p 657, Lindley LJ said:

> Ex turpi causa non oritur actio. This old and well-known legal maxim is founded in good sense and expresses a clear and well-recognized legal principles, which is not confined to indictable offences. No court ought to enforce an illegal contract or allow itself to be made the instrument of enforcing obligations alleged to arise out of a contract or transaction which is illegal, if the illegality is duly brought to the notice of the court, and if the person invoking the aid of the court is himself implicated in the illegality. It matters not whether the defendant has pleaded the illegality or whether he has not. If the evidence adduced by the plaintiff proves the illegality the court ought not to assist him. If authority is wanted for this proposition, it will be found in the well-known judgment of Lord Mansfield in *Holman v Johnson* (1775) 1 Cowp 341, [1775–1802] All ER Rep 98).

The question to pose is this: was there an illegal contract between Fazaruddin and Parkson? The answer is in the negative. Here was a case of expunging the mark as reflected in mark 'A' by Parkson. There was no illegality at all when Fazaruddin authored mark 'A'. Now, if Fazaruddin fraudulently or deceptively used the mark it would be a ground for its removal from the register. The right way to decide the matter would be to pose this crucial question: has Fazaruddin in protecting his proprietorship over the mark, been guilty of a material misrepresentation calculated to mislead the public? Three examples of the kind of material misrepresentations calculated to mislead the public may be cited here. The first would be the case of *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at pp 542 and 543 where a misrepresentation that the plaintiff was a patentee contained in invoices and advertisements was treated as a collateral misrepresentation not disentitling him to an injunction although affecting his right to an account. The second would be the case of *Mrs Pomeroy Ltd v Scale* (1906) 24 RPC 177 at p 192 where the representation was that the defendant was the plaintiff's manager after the defendant had ceased to be such. The third is the case of *Plotzker v Lucas* (1907) 24 RPC 551 at p 562 where it was misrepresented that the plaintiffs were actual manufacturers.

On the facts, there was no material to show fraud on Fazaruddin's part when he registered the mark as reflected in mark 'A' as his own. In my judgment in the absence of fraud, it was not unlawful for Fazaruddin to become the registered proprietor of mark 'A'. Here is a classic case of an

enterprising individual who succeeds in creating mark 'A' and uses it on articles of clothing purely to earn a living. Must his ingenuity be construed fraudulent so as to strike at the very core of the register! It is an insult to intelligence if this court were to hold that Fazaruddin's ingenuity constituted fraud. Mark 'A' should remain on the register.

Other issues

It was submitted that Fazaruddin committed perjury against this court when he said that he applied to register his 'ZIG ZAG' mark at the *Kementerian Perdagangan Dalam Negeri* by letter dated 23 January 1986 and the said *Kementerian* acknowledged receipt on 26 January 1986 (see the letter as produced in the early part of this judgment). In regard to this letter, I was asked to take judicial notice of the following set of facts:

(1) that 26 January 1986 was a Sunday;

(2) that the *Kementerian Perdagangan Dalam Negeri* was not established until 1990 after the general election of that year;

(3) that Menara Mayban, the address of the said *Kementerian* was not completed until 1987 and it was officially declared open by the honourable Prime Minister in June 1988.

On judicial notice, there are a string of authorities. Suffice for this exercise that a few of them are referred to. Thus, in *Whaley v Carlisle* 17 ICLR 792 the court took judicial notice that Lord Hawkesbury had been Foreign Minister in 1803. In *Yong Pak Yong v PP* [1959] MLJ 176, the court there took judicial notice of 'what is notorious, of what everybody knows'. The court in *Pang Ah Chee v Chong Kwee Sang* [1985] 1 MLJ 153, FC took judicial notice that Chinese funeral expenses would normally be incurred. Finally, in *Pembangunan Maha Murni Sdn Bhd v Jururus Ladang Sdn Bhd* [1986] 2 MLJ 30, the then Supreme Court took judicial notice of custom or usage.

Paragraphs (2) and (3) as stated above were ventilated in an affidavit affirmed by Law Boon Eng on 15 March 1996 as reflected in encl 30. It was on 19 March 1996 that encl 30 was filed. Muthalib took the stand on 15 February 1996 and was cross-examined. When the case came up for continued hearing on 19 March 1996, Mr M Nathan for Fazaruddin told the court that he was not calling Boo Ah Lek and, consequently, he was not relying on Boo Ah Lek's 'surat akuan' as reflected in encl 13 exh F3. Mr M Nathan too took up an objection and he submitted that encl 30 ought not to be considered by this court as it came too late in the day. All the deponents to the affidavits have taken the stand and being cross-examined.

It must be stated here that encl 30 was filed to rebut encl 13 especially exh F4. Exhibit F4 is the letter from Fazaruddin to the *Kementerian Perdagangan Dalam Negeri*. Enclosure 13 was filed on 9 March 1995 whereas encl 30 was filed on 19 March 1996 — a delay of one year and ten days. It was argued that Parkson had ample time to file encl 30 yet they chose to do so after a long delay and after all the deponents had been

cross-examined. In *Yah bte Aji v Fatimah bte Hj Mohamed Ariffin & Ors* [1969] 2 MLJ 186, where after the close of the case for the defendants, an application was made to call further evidence for the defence. Counsel for the defendants said that he had unearthed certain evidence which was not only material to the claim but would perhaps be decisive. It was held that the defendant had not shown that the evidence sought to be adduced could not have been obtained with reasonable diligence for use at the trial and therefore the application must be dismissed. Chang Min Tat J, adopted the statement of law propounded by Denning LJ in the case of *Ladd v Marshall* [1954] 1 WLR 1489 to the following effect:

> To justify the reception of fresh evidence or a new trial, three conditions must be fulfilled: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial; secondly, the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; thirdly, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.

Just like Chang Min Tat J in *Yah bte Aji*, I too hold that though the second and third conditions may have been fulfilled (here I express no firm opinion), the first condition was not satisfied and consequently, encl 30 will not be considered by me. Now, even if I were to consider encl 30 it would not make a difference in that on several occasions Fazaruddin in his affidavits, and also while he was in the witness box, categorically stated that he used and designed mark 'A' in 1984. I have no hesitation in accepting Fazaruddin as a truthful witness. Even though Fazaruddin admitted that he was not able to tender proof that he designed mark 'A' in 1984 because all the clothes that bore that mark had been sold, yet he re-emphasized the factual situation by saying that in 1983 he merely had the words 'ZIG ZAG' in mind and by 1984 he designed mark 'A' and used the same for the sports meet at Bandartex. Though Muthalib testified in examination-in-chief that he was working at Soultex ('Soutex') with Fazaruddin between 1981 to 1984 and that he confirmed Fazaruddin's participation in the logo competition, it was sought to argue that Fazaruddin stated that he worked at Bandartex and not at Soultex ('Soutex') and consequently, the evidence of Fazaruddin ought not to be believed. I beg to disagree. In encl 13 exh Fl(B), it clearly showed that both Soultex ('Soutex') and Bandartex were subsidiaries of Berjaya Textiles Bhd. If proof was required that the mark was used by Fazaruddin, there was an invoice dated 26 March 1985 in exh F8 of encl 13 which bore this label (a translation): '20 pasang skirt ketat dengan jenama "ZIG ZAG".' I am even prepared to accept the 'satu gulung label "ZIG ZAG"' tendered by Fazaruddin as exh R3, which according to Fazaruddin was made in 1986, as gospel truth. On the other hand we have the affidavit of Yong Boon Sen in encl 9 which deposed that Parkson had the mark as reflected in mark 'B' in its stable on 10 November 1987. An advertisement exhibited in encl 9 at p 38 thereof and marked as exh P3 showed the date as 24 February 1989. Thus, if we talk about common law usage, Fazaruddin had used the mark earlier in point of time than Parkson.

Next, there was an oral application by Parkson to call a handwriting expert to ascertain whether the words 'ZIG ZAG' that appeared in exh F8 in encl 13 were written by the same person who wrote the words 'ZIG ZAG' in exh F4 (marked as 'P2') of encl 13. The oral application was made on 15 February 1996 after Fazaruddin had been cross-examined and before Muthalib took the stand. It must not be forgotten that cross-examination of the deponents of the affidavits were allowed by this court pursuant to such applications in encls 20 and 25. For Fazaruddin it was argued that if the oral application was allowed it would open the floodgate and Fazaruddin too would be interested in putting to the stand an officer from the Kementerian Perdagangan Dalam Negeri. There would not be any finality to the right to cross-examine. I have no hesitation in refusing the oral application to call a handwriting expert as I felt that there should be finality in litigation. *Jacob v PP* [1949] MLJ 70 can easily be distinguished and is not an authority for Parkson to use in support of their application to call the handwriting expert. *Jacob* was a criminal case and it decided that the court may call further evidence even after the close of the defence if the evidence appears to be essential to the just determination of the case, but should the further evidence prove adverse to the accused then opportunity must be afforded the defence to cross-examine and to call evidence in rebuttal.

Damages

Since judgment should rightly go to Fazaruddin, the prayer by Parkson for damages to be assessed by the registrar must fail.

For the reasons adumbrated above, I dismissed encl 10 paras 3(a), (b) and (c) with costs.

Application dismissed.

Reported by Kenneth Goh